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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,835	03/30/2004	Werner Kalbitz	032301.001	3123
25461	7590	12/01/2004	EXAMINER	
SMITH, GAMBRELL & RUSSELL, LLP SUITE 3100, PROMENADE II 1230 PEACHTREE STREET, N.E. ATLANTA, GA 30309-3592			GREEN, ANTHONY J	
		ART UNIT		PAPER NUMBER
		1755		

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/812,835	KALBITZ ET AL.
	Examiner Anthony J. Green	Art Unit 1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. '11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ .  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The preliminary amendment submitted on 30 June 2004 has been entered.

Currently claims 1-20 are pending.

### ***Specification***

2. The abstract of the disclosure is objected to because it is not in the form of a single paragraph. Correction is required. See MPEP § 608.01(b).
3. The disclosure is objected to because of the following informalities:

The specification is missing a section entitled "Brief Description of the Drawings". Also the patent number recited on page 1, line 10, namely 9,911,935 is incorrect as no patent with that number exists. Applicant needs to provide the correct patent number.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 contains improper Markush terminology due to the use of "selected from the group consisting of...or". The "or" needs to be changed to -- and -- which will overcome the rejection.

In claim 3 the phrase "the gas black content" appears to lack proper antecedent basis.

In claim 4 the phrase "the azo compound content" appears to lack proper antecedent basis.

In claim 11 the phrase "the wetting agent content" appears to lack proper antecedent basis.

In claim 13 the phrase "the additive content" appears to lack proper antecedent basis.

In claim 14 the phrase "the content" and "the salt content" appear to lack proper antecedent basis.

In claim 15 the phrase "the soluble azo compound" lacks proper antecedent basis.

In claim 16 it is unclear as to what is meant by the phrase "Ultra Turrax". If this is a trademark then this term is considered indefinite since the relationship between a trademark and the product it identifies is sometimes indefinite, uncertain or arbitrary. The formula or characteristics of the product may change from time to time and yet it may be sold under the same trademark. In the claims, every element or ingredient of the composition should be set forth in positive, exact, intelligible language so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to

mean different things at the pleasure of manufacturers do not constitute such language.

See MPEP 608.01(v). Ex parte Kattwinkel 12 USPQ 11. It is unclear as to what is meant by the phrase "or comparable unit". The phrase "high-pressure homogenizer" is vague and indefinite as "high" is a relative term.

In claim 19 the phrase "the content of azo compound" appears to lack proper antecedent basis.

In claim 20 the phrase "the content of the azo compound" and "the salt content" lacks proper antecedent basis.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-6 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Specification No. 724,968.

The reference teaches, in the examples on pages 7-8 of the reference, pigment-dye combination inks formed by mixing a pigment ink (carbon black dispersion with a water soluble Dye ink B. The Carbon black is believed to meet applicant's limitation of a gas black. The azo dyes utilized in the examples (i.e. Food Black 2 and Direct Black 168) meet instant formula 1. See the attached Registry documents from Chemical Abstracts which show the formulae of the water soluble dye used in the examples.

The instant claims are met by the reference. It is the position of the examiner that the pigment ink (carbon black dispersion) mixed with the water soluble dye Ink containing an azo dye to form the ink composition meets the instantly claimed colloidal suspension absent evidence showing otherwise. As for the amounts, it appears that the amounts encompass the amounts instantly claimed. As for the salt content, since the azo dye may be in acid form there would be no salt content and therefore applicant's limitation of the salt content is also met.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 2, 7-10, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Specification No. 724,968.

The reference was discussed previously.

The instant claims are obvious over the reference. With respect to claim 2, it is the position of the examiner that it would be obvious to substitute any gas black for the black pigment of the invention absent evidence to the contrary as the reference broadly teaches the use of a carbon black produced by the furnace process or the channel process. As for claim 7 while the reference does not teach the use of the same azo compound, the reference teaches on page 4, that was the water soluble black dye it is

preferable to use those having an anionic group or solubilizing group and it is believed that one may be any azo compound meeting this limitation. Accordingly it would be obvious to substitute other azo compounds, such as those recited in instant claim 7 for the azo compounds of the reference absent evidence showing otherwise. As for claim 8 since the acid form may be utilized it is believed that this claim is met. As for claim 9 the reference teaches the use of a wetting agent and various additives in the examples. As for claim 10, the reference teaches the use of a styrene methacrylic acid-ethyl acrylate solution as the dispersing agent which is believed to meet applicants wetting agent recited in claim 10 absent evidence showing otherwise. As for claim 12, the examples teach the addition of various alcohols and glycol ethers. With respect to claim 13 the amounts of the additives are present in amounts that are less than 30% according to the examples. Accordingly the instant claims are rendered obvious by the references.

#### ***Allowable Subject Matter***

10. Claims would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***References Cited By The Examiner***

11. The references are cited as showing the general state of the art and as such, they are not seen to teach or fairly suggest the instant invention. While EP 1002839

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teaches a mixture of a black dye such as an azo dye and carbon black, the examples recite that the insolubles are removed by filtration and accordingly based on this it is the position of the examiner that a colloidal suspension would not be formed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
November 29, 2004